

#9
Dmt
12-7-01PATENT
DIVER1260-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jay M. Short ✓
 Serial No.: 09/421,629 ✓
 Filed: October 19, 1999
 Title: PROTEIN ACTIVITY SCREENING

Commissioner of Patents
 Washington, D.C. 20231

Art Unit: 1652
 Examiner: N. Nashed

Official Search
 Process
 N. Nashed
 12/16/01

TERMINAL DISCLAIMER

Sir:

The undersigned, attorney of record for Petitioner, DIVERSA CORPORATION, formerly known as Recombinant Biocatalysis, Inc., with its place of business at 4955 Directors Place, San Diego, CA 92121, represents that Petitioner is the Assignee of 100 percent interest in Application Serial No. 08/876,276, filed June 16, 1997, entitled HIGH THROUGH PUT SCREENING FOR NOVEL ENZYMES, as evidenced by an Assignment recorded in the United States Patent and Trademark Office on December 17, 1999, at Reel 010476, Frame 0273.

In addition, the undersigned, attorney of record for Petitioner, DIVERSA CORPORATION, formerly known as Recombinant BioCatalysis, Inc. represents that Petitioner is the Assignee of 100 percent interest in Application Serial No. 08/503,606, filed July 18, 1995, entitled ENZYME ACTIVITY SCREENING OF CLONES HAVING DNA FROM UNCULTIVATED MICROORGANISMS, as evidenced by an Assignment recorded in the United States Patent and Trademark Office on June 3, 1996, at Reel 8018, Frame 0180.

| CERTIFICATION UNDER 37 CFR §1.8 | |
|--|--|
| I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, November 14, 2001, in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231. | |
| <u>Cecilia Tobin</u> <small>(Name of Person Mailing Paper)</small> <u>Cecilia Tobin</u> November 14, 2001 <small>(Signature) (Date)</small> | |

12/07/2001 DTHOMAS 0000001 501355 09421629
 02 FC:248 55.00 CH ✓

Gray Cary/GT/6255800.1
 104703-158574

Applicant: Short, et al.
Serial No.: 09/421,629
Filed: October 19, 1999
Page 2

PATENT
Attorney Docket No.: DIVER1260-3

The evidentiary documents referred to herein have been reviewed by the undersigned and it is certified that to the best of the undersigned's knowledge and belief, title is in the Assignee.

Pursuant to 37 C.F.R. § 1.321(c), the undersigned, on behalf of Petitioner, DIVERSA CORPORATION, disclaims the terminal part of any patent granted on claims 32-47 of the above-identified Application No. 09/421,629 that would extend beyond the expiration date of claims 1-23 of U.S. Patent No. 6,174,673. Petitioner hereby agrees that any patent so granted on claims 32-47 of the above-identified application No. 09/421,629 shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to claims 1-23 of U.S. Patent No. 6,174,673, this Agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successor or assigns.

Pursuant to 37 C.F.R. § 1.321(c), the undersigned, on behalf of Petitioner, DIVERSA CORPORATION, disclaims the terminal part of any patent granted on claims 32-47 of the above-identified Application No. 09/421,629 that would extend beyond the expiration date of claims 1-15 of U.S. Patent No. 5,958,672. Petitioner hereby agrees that any patent so granted on claims 32-47 of the above-identified application No. 09/421,629 shall be enforceable only for and during such period that the legal title to claims 32-47 of said patent shall be the same as the legal title to claims 1-15 of U.S. Patent No. 5,958,672, this Agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successor or assigns.

Pursuant to 37 C.F.R. § 1.321(c), the undersigned, on behalf of Petitioner, DIVERSA CORPORATION, disclaims the terminal part of any patent granted on claims 32-47 of the above-identified Application No. 09/421,629 that would extend beyond the expiration date of claims 1-15 of U.S. Patent No. 6,168,919. Petitioner hereby agrees that any patent so granted on claims 32-47 of the above-identified application No. 09/421,629 shall be enforceable only for and during such period that the legal title to claims 32-47 of said patent shall be the same as the

Applicant: Short, et al.
Serial No.: 09/421,629
Filed: October 19, 1999
Page 3

PATENT
Attorney Docket No.: DIVER1260-3

legal title to claims 1-15 of U.S. Patent No. 6,168,919, this Agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successor or assigns.

In addition, pursuant to 37 C.F.R. § 1.321(c), the undersigned, on behalf of Petitioner, DIVERSA CORPORATION, disclaims the terminal part of any patent granted on the above-identified Application No. 09/421,629 that would extend beyond the expiration date of any patent granted on the subject matter of claims 66-71, 74-85, 89, 90, 92 and 93 of co-pending U.S. Application No. 08/988,224, issued on August 28, 2001 as U.S. Patent 6,280,926. Petitioner hereby agrees that any patent so granted on claims 32-47 of the above-identified application No. 09/421,639 shall be enforceable only for and during such period that the legal title to claims of said patent shall be the same as the legal title to claims of U.S. Patent No. 6,280,926, this Agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successor or assigns.

In addition, pursuant to 37 C.F.R. § 1.321(c), the undersigned, on behalf of Petitioner, DIVERSA CORPORATION, disclaims the terminal part of any patent granted on claims 32-47 of the above-identified Application No. 09/421,629 that would extend beyond the expiration date of any patent granted on claims 2-5 of copending Application No. 09/467,740. Petitioner hereby agrees that any patent so granted on claims 32-47 of the above-identified application No. 09/421,639 shall be enforceable only for and during such period that the legal title to claims of said patent shall be the same as the legal title to any patent granted on claims 2-5 of co-pending U.S. Application No. 09/467,740, this Agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successor or assigns.

Applicant: Short, et al.
Serial No.: 09/421,629
Filed: October 19, 1999
Page 4

PATENT
Attorney Docket No.: DIVER1260-3

To cover the fee to file the Terminal Disclaimer, Applicants enclose herewith a check in the amount of \$55.00. The Commissioner is hereby authorized to charge any additional fee associated with filing this Terminal Disclaimer, or that may be required by this paper, or to credit any overpayment to Deposit Account No. 50-1355. A duplicate copy of the Transmittal Sheet is enclosed.

Respectfully submitted,



Date: November 14, 2001

Lisa A. Haile, J.D., Ph.D.
Registration No.: 38,347
Telephone: 858-677-1456
Facsimile: 858-677-1465

USPTO CUSTOMER NO. 28213

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, CA 92121-2133

Gray Cary\GT\6255800.1
104703-158574